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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/319,384	06/04/1999	TAKASHI ECHIGO	Q54629	2943

7590 02/17/2004

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EXAMINER

PRATS, FRANCISCO CHANDLER

ART UNIT	PAPER NUMBER
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1651

DATE MAILED: 02/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/319,384

Applicant(s)

ECHIGO ET AL.

Examiner

Francisco C Prats

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 January 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 28 January 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1,5,7,8,10-17 and 19.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

Francisco C Prats  
Primary Examiner  
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**ATTACHMENT TO ADVISORY ACTION**

The response filed January 28, 2004, has been received and entered. The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior office action.

All of applicant's argument has been fully considered but is not persuasive of error. Throughout the argument submitted on January 28, 2004, applicant incorrectly asserts that the invention is directed to processes of pressure treating wood. See, e.g., Response of January 28, 2004, sentence spanning pages 2-3. ("The present invention relates to obtaining preserved wood products by impregnating a lignin or ligninosulfate into a wood material, which is a porous substance, with an enzyme having polyphenol oxidizing activity.") See also Response of January 28, 2004, sentence spanning pages 5 and 6. ("As noted above, the method of the present invention comprises impregnating ligninosulfate into wood materials with an enzyme having polyphenol oxidizing activity and performing polymerization by providing oxygen during a drying period of the wood enables impregnation of the solution in a state where the solution has a relatively low molecular weight of ligninosulfate content and hence, a low viscosity, into wood.")

Applicant's characterization of the invention is not accurate. In response to the restriction requirement of March

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23, 2001, applicant elected to prosecute product claims, not process claims. Applicant's claims are not directed to processes of pressure treating wood. Applicant's claims are directed to a composition comprising certain claim-enumerated ingredients. Because applicant elected to prosecute product claims, not process claims, applicant is incorrect in asserting that the claimed process comprises any steps. Rather, the critical inquiry is whether the prior art describes or suggests the claimed subject matter.

Applicant's claims, at their simplest, recite compositions containing(a) a polyphenol oxidase (i.e., a laccase),

(b) a lignosulfonic acid/lignosulfonate compound, and

(c) a chemical agent which may be a metal salt powder, a metal compound, or a metal complex.

Thus, any prior art which combines the claimed ingredients or suggests combining the claimed ingredients will anticipate or render obvious the claimed composition. As discussed in previous office actions, Haars discloses that a solution comprising the claimed enzyme and a lignosulfonate are useful in binding wood chips to make particle boards. As also pointed out in previous office actions, one of ordinary skill in the art would have been motivated to have included wood-preserving compounds such as disclosed by Conradie to ensure the durability

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of the particle boards prepared using Haars' adhesive. Thus, the prior art suggests combining the claimed ingredients. The fact that the cited references are not directed to pressure-treating wood is irrelevant because applicant's claims are not directed to pressure treating wood.

It is noted that the preamble of claim 1, the only independent claim, recites that the composition is "for injection treatment of wood". However, note that the solution exemplified by Haars to bind wood chips together is "the consistency of honey" (Haars, US '921 at column, line 44). Given the proper pre-treatment of the wood, e.g. hole-drilling, Haars' honey-thick solution clearly would be injectable into wood, contrary to applicant's argument. Moreover, given proper pre-treatment or handling of Haars' solution, i.e., injection before thickening or dilution (neither of which is excluded by applicant's claims), Haars' solution clearly could be used to inject into wood. Thus, to the extent that applicant argues that the compositions of the prior art cannot be used in methods of pressure-treating wood because of their viscous and adhesive nature, applicant's argument is incorrect, and ignores the scope of the claimed subject matter.

Moreover, note that a recitation of the intended use of the claimed invention must result in a structural difference between

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the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this regard it is respectfully pointed out that none of the pending claims recites any viscosity limitation. Thus, applicant's argument about the viscosity of the claimed product as conferring a difference between the claims and the prior art is directed to a limitation not present in the claims.

In sum, on the current record, the prior art provides motivation for practicing the invention as claimed. While applicant asserts differences between the claims and prior art based on the intended pressure-treating use of the composition, applicant's claims are not directed to methods of pressure-treating wood, nor do applicant's claims recite any physical properties of the claimed composition which distinguishes over the prior art. The rejections of record must therefore be maintained.

No claims are allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Francisco C Prats whose telephone number is 571-272-0921. The examiner can normally be reached on Monday through Friday, with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Francisco C Prats  
Primary Examiner  
Art Unit 1651